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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,688	12/03/2003	Randall Coleman Gellens	030218	8621
23696 7590 10/01/2008 QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121				
EXAMINER				
TRAN, PHILIP B				
ART UNIT		PAPER NUMBER		
2155				
NOTIFICATION DATE		DELIVERY MODE		
10/01/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/727,688

Applicant(s)

GELLENS ET AL.

Examiner

Philip B. Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 64-71 are objected to because of the following informalities: Claims 64-71 are dependent to independent claim 63 (a computer readable media embodying a program ...) and should be referred to preamble of claim 63 for consistency.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear those steps of receiving, recognizing, identifying, assigning and initiating are performed by what apparatus and data are transferred from which location to which location.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries

include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 38, 47, 56 and 65 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 38, 47, 56 and 65:

- **performing at least one of said receiving, recognizing, identifying, assigning, and initiating in a background mode.**
- **means for performing at least one of said receiving, recognizing, identifying, assigning, and initiating in a background mode.**

- **wherein said processor is configured to perform at least one of said receiving, recognizing, identifying, assigning, and initiating in a background mode.**

Therefore, claims 38, 47, 56 and 65 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claimed limitations.

(2) Claims 38, 47, 56 and 65 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in

addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 38, 47, 56 and 65 :

- **performing at least one of said receiving, recognizing, identifying, assigning, and initiating in a background mode.**
- **means for performing at least one of said receiving, recognizing, identifying, assigning, and initiating in a background mode.**
- **wherein said processor is configured to perform at least one of said receiving, recognizing, identifying, assigning, and initiating in a background mode.**

Undue experimentation would be needed to perform at least one of said receiving, recognizing, identifying, assigning, and initiating in a background mode.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 36-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al (Hereafter, Evans), U.S. Pat. No. 6,690,918 in view of Spratt, U.S. Pat. Application Pub. No. US 2002/0040326 A1.

Regarding claim 36, Evans teaches a method for transferring data, comprising:

receiving one or more registrations, wherein each registration comprises a set of criteria for transferring data (i.e., registering profile for communication) [see Abstract and Col. 2, Lines 23-41];

recognizing a communication link (i.e., maintaining communication connection between devices) [see Figs. 1-2];

identifying selected registrations whose associated set of criteria has been met (i.e., identifying the sending device of profile matched) [see Col. 2, Lines 23-41 and Col. 11, Lines 55-63];

assigning priority indicators to the selected registrations (i.e., enabling priority profile matching) [see Col. 8, Line 59 to Col. 9, Line 3 and Col. 9, Lines 49-58];

initiating a transfer over the communication link (i.e., initiating communication between the communications devices involved in the profile match. There should be data exchanging between devices) [see Abstract and Col. 11, Lines 64-67].

Evans does not explicitly teach transferring data associated with the selected registrations (profile) based on the priority indicators. However, Spratt, in the same field of transferring data endeavor, discloses assigning priority to the content items (music items) and downloading items associated with the preference profile (registrations data) based on priority [see Spratt, Abstract and Paragraphs 0081-0082 & 0091]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Spratt into the teaching of Evans in order to efficiently perform priority-based flow control of data and thus the traffic congestion in the network can be under well control for increasing the network throughput.

Regarding claim 37, Evans further teaches the method of claim 36, wherein the set of criteria identifies at least one of an amount of data to be transferred, a type of data to be transferred, a type of communication link, the amount of data currently being sent over the communication link, an available data transfer rate, power consumption associated with transmitting the data, an amount of data packet re-transmissions per unit time, a battery power level, a user activity level, and a time of day indicator [see Col. 8, Lines 23-33].

Regarding claim 38, Evans and Spratt do not explicitly teach the method of claim 36, further comprising performing at least one of said receiving, recognizing, identifying, assigning, and initiating in a background mode. However, it would have been obvious to one skilled in the art to recognize that performing step in a background mode is known to efficiently avoid the latency of transferring data over the network and thus reducing the traffic congestion in the network.

Regarding claim 39, Evans further teaches the method of claim 36, further comprising performing the method on a device chosen from a group of devices comprising a personal laptop computer, a personal standup computer, a wireless communication device, a still camera, a video camera, an audio recording device and a PDA (i.e., wireless device and palm device) [see Fig. 1].

Regarding claim 40, Evans further teaches the method of claim 36, wherein the data represents at least one of keystroke information, files viewed, files created, websites visited, and software application usage (i.e., accessing to website) [see Col. 8, Lines 35-48].

Regarding claim 41, Evans further teaches the method of claim 36, wherein the one or more registrations identify at least one of opportunistic data transfers and periodic data transfers (i.e., communication when profile matched) [see Abstract and Col. 2, Lines 23-41].

Regarding claim 42, Evans further teaches the method of claim 36, wherein said recognizing comprises establishing the communication link if the communication link is not recognized within a selected time interval [see Figs. 1-2 and Col. 2, Lines 23-41].

Regarding claim 43, Evans further teaches the method of claim 36, wherein the communication link is at least one of a traffic channel and a supplemental channel [see Figs. 1-2].

Regarding claim 44, Evans further teaches the method of claim 36, wherein the data comprises at least one of a notification request and a data exchange associated with at least one of an email program, a stock quote utility, an MMS utility, an instant messaging client, networked games, a weather checker, a person locator, a location monitor, a news checker, and a medical reminder (i.e., instant messaging) [see Col. 9, Lines 5-9].

Claim 45 is rejected under the same rationale set forth above to claim 36.

Claims 46-53 are rejected under the same rationale set forth above to claims 37-44.

Claim 54 is rejected under the same rationale set forth above to claim 36.

Claims 55-62 are rejected under the same rationale set forth above to claims 37-44.

Claim 63 is rejected under the same rationale set forth above to claim 36.

Claims 64-71 are rejected under the same rationale set forth above to claims 37-44.

Other References Cited

7. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

A) Carhart et al, U.S. Pat. Application Pub. No. US 2005/0108754 A1.

B) Salas et al, U.S. Pat. No. 7,249,176.

Response to Arguments

8. Applicant's arguments with respect to claims 36-71 have been considered but are moot in view of the new ground(s) of rejection.

9. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip B Tran/
Primary Examiner, Art Unit 2155
September 23, 2008

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